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09/746,751	12/21/2000	Brian W. Hedrick	104014	1028

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EXAMINER
NORTON, NADINE GEORGIANNA

ART UNIT	PAPER NUMBER
1764	6

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Please find below and/or attached an Office communication concerning this application or proceeding.

mk-6

Office Action Summary	Application No. 09/746,751	Applicant(s) HEDRICK, BRIAN W.	
	Examiner Nadine Norton	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 December 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) *19-27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☒ Claim(s) *12 and 14* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2, 4, 5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-18, drawn to a process, classified in class 208, subclass 150.

II. Claim 19-27, drawn to an apparatus, classified in class 422, subclass 144.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the stripping of entrained and/or adsorbed hydrocarbons can be accomplished with a materially different apparatus such as a cyclone separator followed by contacting with stripping steam in the absence of baffles.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with James Paschall on 8-14-02 a provisional election was made with traverse to prosecute the invention of I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

The abstract of the disclosure is objected to because it is longer than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 12 and 14 are objected to because of the following informalities:

In claim 12, lines 2-3 applicant uses the phrase "an particulate material" it appears as if applicants intend to use "a" instead of "an".

In claim 14, it appears as if applicant intends to claim the plural form of the term "opening".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, lines 2-3, applicant uses the phrase "the fluidized catalytic cracking". The phrase lacks proper antecedent basis in the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lomas (6,010,618).

Applicant is claiming a method of stripping entrained and/or adsorbed hydrocarbons from particulate material. Applicants' process involves the use of a plurality of sloped baffles with a plurality of openings with specific specifications as defined in the claims.

The reference of Lomas (6,010,618) discloses an FCC process involving the stripping of particulates in the form of catalyst with sloped baffles containing a series of holes. See column 8, lines 65-68. The catalyst is passed downward and stripping gas is passed upward in a countercurrent manner. See column 9, lines 1-5. Lomas discloses an additional step wherein the stripped particles containing coke are regenerated. See column 9. lines 1-5.

The reference of Lomas (6,010,618) succeeds in disclosing countercurrent stripping in the presence of sloped baffles containing multiple holes and coked catalyst regeneration steps corresponding to those claimed by applicant.

A difference is noted between the reference of Lomas (6,010,618) and applicant's claimed invention. The reference is silent about the specific configurations of the holes in the baffles.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select and arrange holes of any size and configuration in the baffles of the Lomas (6,010,618) process that would accomplish desirable stripping, including the specific specifications defined in applicant's claims, because it has been held that changes in size are not a matter of invention. In re Rose, 105 USPQ 237 (CCPA 1955). In addition, it has been held that invention in a method must be found in the steps performed and not the apparatus employed. See Ex Parte Hart, 117 USPQ 193 (Bd. PatApp. & Int. 1958). In this case, applicant's specific baffle opening configuration does not appear to distinguish over the process steps of the applied art.

Claim Rejections - 35 USC § 103

Claims 9-11 and 17- 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lomas (6,010,618) as applied to claims 1-8 and 12-16 above, and further in view of Johnson et al.(5,531,884).

It is noted that the reference of Johnson et al.(5,531,884) is silent about the flux rate through the stripper and the angle of the baffles.

The reference of Johnson et al.(5,531,884) is cited to illustrate that strippers are known to contain plates with angles of 30-60 degrees. See column 3, lines 45-55. Johnson et al.(5,531,884) also discloses a catalyst flux of 39 lb/ft2/s (140,400 lb/ft2/hr). See column 13, lines 20-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made practicing the process of Lomas (6,010,884) to select baffle angles and stripper flux

rates overlapping those claimed by applicants because the reference of Johnson et al.(5,531,884) illustrates that such angles and flux rates are successful for accomplishing stripping.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 09/877,981.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09/877,981 defines a baffle slope of less than or equal to 10° whereas the present application is silent about the specific angle of the slope.

The angle of the slope of the apparatus is not considered to be a patentably distinguishing limitation for the claimed process. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select any slope that would accomplish desirable stripping, including the specific slope defined in the claims of Application No.09/877,981, because it has

been held that invention in a method must be found in the steps performed and not the apparatus employed. See Ex Parte Hart, 117 USPQ 193 (Bd. PatApp. & Int. 1958).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-8 and 11-16 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 17-20 of copending Application No. 09/990,244. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of Application No.09/990,244 include different limitations defining the shape of the baffles employed during the claimed stripping process.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the present process would accomplish similar stripping to the process defined in the claims of U.S. Application No.09/990,244 despite slight structural differences in the baffles employed because similar countercurrent particle/stripping gas contacting steps are performed. It has been held that invention in a method must be found in the steps performed and not the apparatus employed. See Ex Parte Hart, 117 USPQ 193 (Bd. PatApp. & Int. 1958).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Prior Art of Record

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The attached references disclose processes involving the stripping of particles with baffles including a single hole (or doughnut shape) and/or sloped baffles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadine Norton whose telephone number is 703-305-2667. The examiner can normally be reached on Monday through Thursday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on 703-308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.

N.N.
August 21, 2002

NADINE G. NORTON
PRIMARY EXAMINER